

result of the discussion, Examiner Caputa requested that Applicants submit their remarks in a Response, and this Response is submitted according to that request.

Reconsideration of the finding of non-responsiveness is respectfully requested. Withdrawal of the finding and entry of the amendment of November 4, 2002, is requested. In making this request, Applicants note the following points.

1) New claims 31-44 fall within the definition of Restriction Group 1.

Applicants have elected Restriction Group I, defined in the restriction requirement in the Office action of July 31, 2001. That Office action (page 2) defines Group 1 as follows:

“1. Claims 1-13, 16-22 drawn to a method for detecting carcinoembryonic antigens (CEAs) or a method for detecting cancer comprising using an antibody against a constant region of CEA and [a] protein capable of recognizing a modified sugar chain structure of CEAs, classified in class 435, subclass 4, 7.1”

This restriction group definition is clearly based on the recitation of original claim 1, which recites a method “using an antibody against a constant region of carcinoembryonic antigens” and “a protein capable of recognizing a modified sugar chain structure of carcinoembryonic antigens.”

Applicants assert that new claims 31-44 all fall within the scope of the restriction group definition.

Specifically:

a) The preamble to independent claim 31 is “A method for detecting cancer ...,” consistent with the definition of Group 1. Moreover, the steps of claim 31 clearly involve a method for detecting carcinoembryonic antigens having a particular sugar chain structure.

b) Claim 31 recites adding “an antibody against a constant region of carcinoembryonic

antigens.” This is clearly “using an antibody against a constant region of carcinoembryonic antigens,” as stated in the restriction group definition.

c) Claim 31 involves addition of “a first protein, said first protein being one that selectively binds to a first sugar chain structure” in step i)a), and “a second protein, said second protein being one that selectively binds to a second sugar chain structure different from said first sugar chain structure.” At least one of these must be “[a] protein capable of recognizing a modified sugar chain structure of CEAs.” Applicants note that, in response to a rejection under 35 U.S.C. 112, second paragraph in the Office action of May 21, 2002, the claim language has been amended to delete the word “modified,” which was considered indefinite. This point is discussed further below.

Accordingly, claim 31 can be seen to meet the definition of restriction group 1 and to fall within the scope of original claim 1.

2) The Rationale for the finding of Claims reading on Non-elected invention appears improper.

In the Office action of November 4, 2002, the Examiner states that the new claims are not readable on the elected invention because “they present additional method steps and new limitations which were not previously considered.”

Applicants respectfully submit that the addition of method steps and new limitations to a claim in general only narrows the claim within the original scope. It is, for example, common to add new dependent claims adding additional limitations, and such claims could not properly be found to no longer read on the invention of the base claim.

The Examiner (page 2, line 13) states: “Not only are the claims not readable on the elected

invention for the reasons set forth above but the new claims also would be subject to further restriction requirements” It is certainly the prerogative of the Examiner to issue additional restriction requirements. Applicants respectfully submit that the Examiner’s indication that additional searching might be needed for the new claims, however, is not a finding that the new claims do not read on the elected invention. As noted above, the addition of a limitation, for example in a dependent claim, does not mean that the dependent claim does not read on the invention of the base claim, even if additional searching is required.

3) Regarding the Telephone interview with Examiners Nickol and Caputa on December 17, 2002.

In the telephone interview, Examiner Caputa raised the following points:

a) Original claim 31 is directed to the detection of an antigen, while claim 31 is directed to detection of cancer.

b) Original claim 1 uses a protein capable of recognizing a modified sugar chain structure of carcinoembryonic antigens, while claim 31 is directed to a protein that selectively binds to a sugar chain structure.

c) The term “modified sugar chain structure” is used in claim 1, while “first sugar chain structure” is used in claim 31.

In response, Applicants explained:

a) Restriction group 1, as defined, includes a method for detecting cancer, and claim 31 includes detection of the antigen. Moreover, claim 31 clearly involves detection of carcinoembryonic antigens.

b) The “first protein being one that selectively binds to a first sugar chain structure” is clearly being used to bind to the sugar chain of carcinoembryonic antigens, as may be seen in claim 31, step i)b), regarding “detecting if a complex is formed of said first protein, said antibody and carcinoembryonic antigen.”

c) The term “modified” was the source of a rejection under 35 U.S.C. 112, second paragraph, in the Office action of May 21, 2002. Therefore, it was necessary that the term “modified” be replaced with more definite wording. The original term “modified” was intended to mean “different”, as may be seen from the present specification. The concept of the protein in claim 31 is the same as in original claim 1, but for clarity, claim 31 recites “a first sugar chain structure” and “a second sugar chain structure different from said first sugar chain structure”, thereby eliminating any indefiniteness resulting from the term “modified sugar chain structure”.

Applicants therefore respectfully request that the finding that claims 31-44 are directed to a non-elected invention be withdrawn, and that an Office action be issued after examining claims 31-44 on the merits.

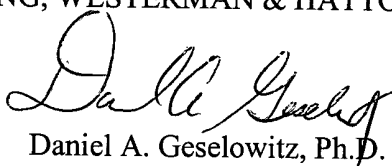
Response
Hideaki HOSOKAWA et al.

U.S. Patent Application S.N. 09/594,577
Attorney Docket No. 000683

In the event that this paper is not timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 01-2340.

Respectfully submitted,

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